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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/337,096 | 06/21/1999 | KENNETH A. NICOLL | 7610 | 8518 |

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INTELLECTUAL PROPERTY SECTION ECD 2
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EXAMINER

WEISBERGER, RICHARD C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2164

DATE MAILED: 03/15/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

12

Office Action Summary

Application No.

09/337,096

Applicant(s)

NICOLL ET AL.

Examiner

Richard C. Weisberger

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims rejected under 35 U.S.C. 102(a) as being anticipated by Billers

Benefit when the bills's not in the mail, Bank Network News, V15, n8, p4-5, sep 11, 1996.

The prior art teaches – the short yet comprehensive article is included in full - (A) an automated terminal for receiving payments (claim 1), (B) a payment system (claims 5-6) for cash payments, a self service terminal for user to pay a provider for goods and services (claims 7, 10, and 13) and (C) methods of performing the same (claims 17-19). The article is directed to the work of ATM Carplay.

Most marketing of home banking programs focuses on consumer convenience. But some believe these programs will really take off when major companies see the advantage of presenting their bills electronically, giving them an incentive to encourage consumer use of this channel.

"Electronic bill presentment is the pony in the deal for the billers," says Ronald V. Hodges, senior vice president, Visa International. And some believe there could be rewards for banks as well, both in cost savings and marketing opportunities.

Advocates point to several benefits of electronic bill presentment. First, there are the cost savings to the billers, who are estimated to spend between 40 cents and \$1 to print and mail bills and related marketing material. "We may be able to take that cost down by more than half through electronic invoice delivery," says Michael W. Anderson, vice president and utility industry marketing manager, Pittsburgh-based Mellon Bank.

Second, electronic delivery can improve cash flow by allowing a consumer to review the bill and click a button to pay it immediately or on the date due. Faster payment can have a big impact on the bottom line, as shown by a recent Gallup Poll in which executives at major U.S. companies said they could boost their companies' profits by 1 % if they could receive payments one day earlier.

Finally, a direct line to the consumer offers both billers and banks

opportunities to build customer loyalty and to target market services to specific consumer segments.

The potential is attracting both new and established players. A startup company called ATM Cardpay Corp. of Wilmington, Del., is trying to interest banks, billers and EFT networks in a scheme in which billers would send bills to a central site via electronic mail. Consumers would gain access to their bills by using their ATM card and personal identification number, either at an ATM or at a home computer equipped with a PIN pad.

A variation on that theme has been developed by Electronic Funds and Data Corp., Bridgehampton, N.Y., which has a World Wide Web site that can accept a virtual replica of a bill, complete with graphics and marketing material. Not only can consumers see their bills by going to the Web site, the site can include dynamic links to other sites. "We have a Nynex bill up now that links to multiple Nynex sites, such as one on caller ID," says Gary T. Glanz, president. "These links will allow them to do affinity-based licensing that can turn this bill into a profit center, instead of a drain." Glanz says a New York-area utility will begin testing the system in October. **Choosing To Pay**

More than 120,000 customers of Southern California Edison already are signed up for a program that gives them the option of having a bill paid automatically when it is due-as in the direct debit programs used by many utilities-or using the telephone to find out the amount of the bill and to set a time to pay it.

Twenty percent chose the latter option although it costs 20 cents, while the automatic payment is free, says Donald C. Licciardello, president, Princeton Telecom, the Princeton, N.J., processor of electronic remittances that developed the program called 1-800-PayBill. Consumers who choose to receive the bill by phone call a toll-free number and enter a PIN. "We present you with your amount due and tell you to press the pound sign if you wish to pay this amount," Licciardello says. "It takes five keystrokes." Fourteen other utilities are signed up for the program, including New Jersey-based Public Service Electric & Gas, and Philadelphia-based Bell Atlantic.

Among those working on delivering bills to consumer's personal computers is Checkfree Corp., Columbus, Ohio, one of the leading bill payment processors. More than 2,500 consumers now receive bills in pilot tests with Dallas-based Capstead Mortgage, St. Louis-based Southwestern Bell, GPU Energy of Reading, Pa., and the Small Business Administration. **Graphic Capabilities**

Currently bills are sent via textonly electronic mail. Full graphical functionality, allowing the biller to include its logo and illustrated marketing material, will be introduced in the fourth quarter, says Ginger B. Moses, product manager for the E-Bill service. Moses says Checkfree has found an encouraging response from consumers to the concept of electronic bill delivery. She says 50% of Checkfree customers expressed interest, as did more than 30% of other consumers.

While not providing details, Moses says Checkfree will collaborate with others on bill delivery. She says that includes Visa, which is developing one of the most ballyhooed initiatives in bill presentment called ePay. "If all parties work together to grow this market, it makes it easier for billers to go forward," Moses says.

ePay is a bi-directional system that can carry remittance information from consumers to billers, by way of the billers' concentrator banks, and billing information from the biller to the consumer. While the part of ePay that carries remittances to the billers is up and running, the presentment portion is not expected to be available until early 1997, about six months behind schedule.

Visa executives say ePay will reflect extensive work with billers about how they want their invoices presented, both for marketing reasons and to meet regulatory requirements. A product like ePay aimed at consumers requires much richer graphical and interactive capabilities than company-to-company electronic data interchange that is used to send bills and payments in the corporate world, says Ray Kolling, a Visa vice president who has helped develop ePay.

"EDI standards are fine for commercial purposes but not for consumer invoicing," Kolling says. "Billers view those invoices as a form of marketing."

ePay also will be interactive, including a button that would allow the consumer to pay a bill immediately, potentially improving the biller's cash flows. And it will include such dynamic links as an electricity bill with a button that says "Are you interested in a more energy-efficient refrigerator?" Says Kolling, "If I hit 'yes,' I'm taken to the electric company's home page for information about GE refrigerators, or to Circuit City where I can buy it."

In addition, offers can be varied according to consumer segment, allowing targeted marketing at a lower cost than printing different brochures for different customers, says Mellon's Anderson. "Today these programs are sold to receivables managers as a way to cut costs. In the future, they will be aimed at the billers' marketing organizations."

Banks, too, can take advantage of this potential by including targeted messages to consumers on their own statements, or in collaborative efforts with billers. "Electronically it's a lot easier to target a message to a market of one than it is on paper," says Charles B. Wickenden, manager of electronic commerce at Jacksonville, Fla.-based Barnett Banks, a bank that has signed up for ePay. "All they have to do is put a button on my bill that says, 'Special on car loans.' If I hit that button, I've self-selected myself as interested in that product."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-31 rejected under 35 U.S.C. 103(a) as being unpatentable over by Billers Benefit when the bills's not in the mail, Bank Network News, V15, n8, p4-5, sep 11, 1996.


The complete teaching can be found in the rejection under 102. The prior art fails to teach of (A) an automated terminal for receiving payments for a mobile telephone service (claims 2-4); (B) a payment system for cash payments, a self service terminal for user to pay a provider for goods and services for a telephone service (Claims 8,9,11-12, and 14-16); and (C) methods of performing the same (claims 28-31). The reference is not however limited to its preferred embodiments and working examples and may be considered for what it would have taught one of ordinary skill in view of all knowledge in the art. Accordingly, it would have been obvious for providers of telephone service to adopt the invention of the prior art and in doing so rendering obvious each and every of the claimed limitations.

Request for Information under rule 1.105

1. Is the applicant and or the applicant's counsel aware of any non-patent literature discussing the products and activities of "ATM Cardpay" (see above rejection.)? Is so please provide copies and/or citations.

2. Notwithstanding the date of use, is the applicant or the applicants counsel aware of companies developing products and/or services and engages in the sale of products and/or services of similar scope to the inventions of claims 1,5,7,10,13,16,17,20,24, and/or 28 ?

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard C Weisberger at 703 308 4408 or via email at Richard.weisberger@uspto.org.

 Richard C Weisberger
Primary Examiner
Art Unit 2164

rw
March 10, 2002